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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Allen, Keith D.	Examiner:	Qian, Celine X.
Serial No.:	09/815,937	Group Art Unit:	1636
Filed:	March 22, 2001	Docket No.:	R611/75658.269
Title:	Transgenic Mice Containing Lymphoid-Specific GPCR Gene Disruptions		

REMARKS

MS RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A Notice of Appeal was filed in the instant case on June 10, 2005, along with Amendment/Remarks and a declaration pursuant to 37 C.F.R. § 1.132 signed by Robert Driscoll. In an Advisory Action mailed July 5, 2005, the Examiner indicated that the amendments to the claims were entered, but that the declaration was not entered. Accordingly, the declaration of Robert Driscoll is now provided as a required submission under 37 C.F.R. § 1.114 with a Request for Continued Examination.

Remarks begin on page 2 of this paper.

REMARKS

Applicant gratefully acknowledges the Examiner's entry of the amendments to the claims filed June 10, 2005. Applicant hereby incorporates by reference in their entirety the arguments filed with the amendment of June 10, 2005. See M.P.E.P. § 706.07(h).II.

Following entry of the amendment filed June 10, 2005, claims 63-70 and 72-76 are pending, and claims 63-70 and 72-76 stand rejected.

Rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph

As argued previously, the commercial use and success of the claimed invention is demonstrated by: (1) delivery of the claimed invention to at least one large pharmaceutical company; and (2) commercial use of DeltaBase by three of the world's largest pharmaceutical companies, Merck, Pfizer and GlaxoSmithKline. DeltaBase incorporates the data set forth in the specification with regard to phenotypic analyses of the claimed mouse.

Applicant is also submitting herewith, as evidence of such sales and purpose of such use, a Rule 132 Declaration from Robert Driscoll, Vice President of Intellectual Property & Legal Affairs of Assignee, Deltagen.

With regard to supporting caselaw, Applicant respectfully directs the Examiner's attention to the following passage from the Federal Circuit's opinion in *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 220 U.S.P.Q. 592 (Fed. Cir. 1983):

> A correct finding of infringement of otherwise valid claims mandates as a matter of law a finding of utility under § 101. *See e.g., E.I. du Pont de Nemours & Co. v. Berkley & Co., supra,* 620 F.2d at 1258-61, 205 USPQ at 8-11; *Tapco Products Co. v. Van Mark Products Corp.*, 446 F.2d 420, 428, 170 USPQ 550, 555-56 (6th Cir.), *cert. denied*, 404 U.S. 986, 92 S. Ct. 451, 30 L. Ed. 2d 370 (1971). The rule is not related, as Raytheon argues, to whether a defendant may simultaneously assert non-utility and non-infringement; a defendant may do so. The rule relates to the time of decision not to the time of trial, and is but a common sense approach to the law. If a party has made, sold, or used a properly claimed device, and has thus infringed, proof of that device's utility is thereby established. People rarely, if ever, appropriate useless inventions.

724 F.2d at 959, 220 U.S.P.Q. at 592.

As succinctly stated by the Federal Circuit, common sense dictates that if a claimed invention has been sold and is being used, its utility is thereby established. Just as people rarely, if ever, appropriate useless inventions, large pharmaceutical companies, rarely if ever, purchase useless inventions.

Applicant also respectfully directs the Examiner's attention to a recently issued opinion from the Federal Circuit:

> Fisher did not present any evidence showing that agricultural companies have purchased or even expressed any interest in the claimed ESTs. And, it is entirely unclear from the record whether such business entities ever will. Accordingly, while commercial success may support the utility of an invention, it does not do so in this case. See Raytheon Co. v. Roper., 724 F.2d 951, 959 (Fed. Cir. 1983) (stating that proof of a utility may be supported when a claimed invention meets with commercial success).

(*In re Fisher*, 04-1465, 22 (Fed. Cir. 2005)). Unlike *Fisher*, Applicant has now submitted evidence that the claimed invention has been purchased and delivered to at least one large pharmaceutical company. In addition, Applicant has demonstrated commercial use of the phenotypic data derived from Applicant's analyses of the claimed mouse by three pharmaceutical companies. Applicant respectfully submits that this evidence establishes the utility of the claimed invention. Accordingly, withdrawal of the 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph rejection is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

Applicant gratefully acknowledges the Examiner's withdrawal of the 35 U.S.C. § 112, first paragraph (new matter) rejections of claims 63-70 and 72-75.

Rejection under 35 U.S.C. § 112, second paragraph

Applicant gratefully acknowledges the Examiner's withdrawal of the 35 U.S.C. § 112, second paragraph rejections of claim 70 as allegedly being indefinite.

Conclusion

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution

of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

This constitutes a request for any needed extension of time under 37 C.F.R. § 1.136(a) and an authorization to charge all fees therefore to deposit account No. 502775 if not otherwise specifically requested.

The Commissioner is hereby authorized to charge any required fees not included, or any deficiency of fees submitted herewith, or credit any overpayment to Deposit Account No. 502775.

Respectfully submitted,

9/12/2005
Date

Steven N. Hird, Reg. No. 51,112
Greenberg Traurig LLP
1200 17th Street, Suite 2400
Denver, CO 80202
(303) 685-7414
(720) 904-6114 (fax)